

09/823,626



Patent

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

David K. BRAVERMAN

Conf. No.: 6953

Application No.: 09/823,626

Group Art Unit: 2171

Filed: March 30, 2001

Examiner: Leroux, Etienne Pierre

Attorney Docket: 09710-1067

Client Docket: COS 99 036

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For: ACCOUNT MANAGEMENT TOOL FOR E-BILLING SYSTEM

AUG 02 2004

APPEAL BRIEF

Technology Center 2100

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is submitted, in triplicate, in support of the Notice of Appeal dated June 4, 2004.

I. REAL PARTY IN INTEREST

MCI, Inc. is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals or interferences.

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III. STATUS OF THE CLAIMS

Claims 1-34 are pending in this appeal. No claim is allowed or canceled. This appeal is therefore taken from the final rejection of claims 1-34 on March 4, 2004.

IV. STATUS OF AMENDMENTS

No amendment has been made to claims 1-34.

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V. SUMMARY OF THE INVENTION

The present invention addresses problems associated with providing internal sales representatives with updated customer e-billing account activity. (Specification, page 1, ¶ 2) Existing comprehensive world-wide-web/Internet-based invoicing and payment systems ("e-billing" systems) enable customers to easily receive and analyze their invoices, and, in addition, enable customers to pay their invoices, electronically via electronic funds transfer. This e-billing system includes a comprehensive software and system infrastructure that provides a variety of tools for enabling customers of telecom companies to receive, analyze and pay their invoices by a variety of methods, via a single comprehensive interface. (Specification, page 2, ¶ 4) The present invention addresses these needs by providing an e-billing system that provides a sales representative with an account management tool that enables a company's sales force to better manage/track their e-billing customers, e.g., by permitting a company's sales force to view all of their invoices and/or companies that are on e-billing. (Specification, page 2, ¶ 6)

In one embodiment, an account management methodology and system for sales representatives of an enterprise employing an e-billing system includes a computer system accessible for on-line interactive communication of product and service invoices to users, the account management tool including a database for storing customer account information

including customer invoices, the customer information including information for associating a customer account with a particular sales representative; a mechanism for retrieving from the database a list of all customer accounts associated with the sales representative; and a device for transmitting a list of customer accounts associated with the sales representative to a service representative browser device for display thereof, whereby customer account information associated with the sales representative is available for review. (Specification, pp. 2-3, ¶ 7)

Referring to Figure 3(a), upon log on and authentication as an agent (i.e., Sales Representative (SR)), a Sales Representative (SR) home page 50 is generated for download to the SR user browser. The SR home page 50 is provided with main menu option choices including a first link 52 to an account list for providing the SR with the ability to view all accounts to which that SR is associated, a second link 54 for providing the SR with the ability to access a specific account invoice or view a specific account through the SR view account list, and a third link 56 for providing the SR with the ability to set provisions within the e-billing system enabling the SR to receive an e-mail notification each time an e-billing account is associated to that SR's user id, and enabling the SR to receive an e-mail notification each time an account that is associated to that SR's user id becomes deleted. (Specification, page 10, ¶ 28)

When the SR selects view account list link 52, the internal SR user is presented with a web based display screen 60, an example of which is depicted in Figure 3(b), having a frame 62 automatically populated with all of the accounts 66 associated with that SR. The internal SR user will thus be able to view all of the account list results 66 for that SR. Account information provided in the list results include Account name, number, account address, account type, level, environment number and account alias. (Specification, page 10, ¶ 29) The SR is thus advantageously equipped with greater access to account information and more timely information

related to the customer base of the Sales Representative, thus fostering more e-billing to provide timely and efficient processing of bills. (Specification, page 16, ¶ 41)

VI. ISSUES

A. Whether claim 1 is anticipated under 35 U.S.C. § 102(e) by *Watson* (U.S. Patent No. 5,991,750).

B. Whether claims 6, 11, 16, 21, 26, and 32 are obvious under 35 U.S.C. § 103 based on *Watson* in view of *Walker et al.* (U.S. Patent No. 6,616,458).

C. Whether claims 2, 7, 12, 17, 22, and 27 are obvious under 35 U.S.C. § 103(a) based on *Watson* in view of *Peters et al.* (U.S. Patent No. 5,724,584).

D. Whether claims 3, 4, 8, 9, 13, 14, 18, 19, 23, 24, 28, 29, 30, 33, and 34 are obvious under 35 U.S.C. § 103 based on *Watson* in view of *Cook* (U.S. Patent No. 6,496,744).

E. Whether claims 5, 10, 15, 20, 25, and 31 are obvious under 35 U.S.C. § 103 based on *Watson* in view of *Goldband et al.* (U.S. Patent Application Publication No. US 2001/0018673).

VII. GROUPING OF CLAIMS

The claims should not be regarded as all standing together since the claims recite respective limitations that render each of the claims separately patentable. For the purposes of this appeal, the following groups are recognized:

A. Claim 1.

B. Claims 6, 11, 16, 21, 26, and 32.

C. Claims 2, 7, 12, 17, 22, and 27.

D. Claims 3, 4, 8, 9, 13, 14, 18, 19, 23, 24, 28, 29, 30, 33, and 34.

E. Claims 5, 10, 15, 20, 25, and 31.

VIII. ARGUMENTS

A. CLAIM 1 IS NOT ANTICIPATED BY WATSON, BECAUSE WATSON FAILS TO DISCLOSE “INFORMATION FOR ASSOCIATING EACH OF THE PLURALITY OF CUSTOMERS WITH A PARTICULAR AGENT AMONG A PLURALITY OF AGENTS.”

To anticipate a patent claim, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

The rejection of claim 1 must be reversed, because *Watson* does not disclose the limitations of the claims.

Claim 1 recites, “storing account information of a plurality of customers in a database, the account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents” and “generating a list of customer accounts corresponding to the particular agent from the account information; and displaying the list via a web browser to the agent.”

By contrast, *Watson* (Per Abstract) is directed to an account processing method for providing specific pre-authorization parameters for categories of transactions that would otherwise be completely denied. Upon establishment of an account, certain categories of transactions are specified as needing specific authorization prior to approving the transaction as requested by a merchant. An account issuer provides a service to account members that permits

an account manager to independently specify the parametric conditions under which to approve a transaction within such categories.

The Examiner asserts, “Watson ‘750 discloses a method for providing an on-line billing system, the method comprising: storing account information of a plurality of customers in a database, the account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents [account manager may be in charge of many accounts, col 6, lines 60-65].” (Office Action of March 4, 2004, Page 2, lines 13-18) However, the cited passage of col. 6, lines 60-65 states:

As used herein, the term "account manager" refers to an individual or organization charged with establishing and monitoring an account. An account manager may be in charge of many accounts and take the form of fleet managers, accounting managers, claims adjusters and also prudent account users.

This passage thus refers to an account manager who may establish and monitor many accounts, but does not disclose use of “account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents.” That is, the mere existence of an account manager does not entail the use of information to associate the accounts with the account manager, particularly in the manner claimed; there is simply no factual basis for the interpretation adopted by the Office Action. In fact, in the entire specification of *Watson* there is only discussion of a singular “account manager,” and thus, never a need to associate the accounts.

The Examiner further asserts *Watson* discloses “generating a list of customer accounts corresponding to the particular agent from the account information” citing Fig 5, 504 and col. 7, lines 23-30. (Office Action of March 4, 2004, Page 2, lines 19-20). The cited passage of col. 7, lines 23-30 merely provides a definition of the term “account issuer” as an organization providing

administrative services to an account user and a card company or authorizing agent. The account manager may also provide augmented services to an account user or manager such as access to an authorizing agent for account establishment and other functions such as pre-authorization.

Furthermore, with respect to this claim feature, the Examiner notes the use of a transaction identifier and the “display of multiple customer accounts” (per FIG. 5). (Office Action of March 4, 2004, “Response to Arguments,” Pages 8-9) However, *Watson*’s disclosure of the transaction identifier is as follows: “a transaction identifier 510 may be associated to a pre-authorized transaction generated by an account manager” (col. 12: 19-21). Col. 4: 19-35 of *Watson* also discloses that “the transaction identifier is included with the generic billing information (e.g., transaction amount, merchant information, etc.) thus allowing an account manager to reconcile their accounting from a billing account information containing the transaction having the transaction identifier associated thereto with a pre-transaction assignment of a traditional identifier such as purchase order number, work order number, or insurance claim number.” Col. 12: 33-36 of *Watson* states, “Transaction identifier 510, by containing descriptive information unique to the transaction, enables an account manager to quickly identify a corresponding authorization document for account reconciliation.” Col. 13: 35-40 of *Watson* states, “Furthermore, to aid account manager 602 (i.e., claims adjuster) in reconciling their accounting system, account manager 602 includes a transaction identifier, which by way of example may be in the form of an insurance claim number uniquely identifying the requested claim by the insured.” Thus, the transaction identifier, as the label suggests, is associated with the **transaction**, not the account manager.

As for FIG. 5, this is “a depiction of an account report associating a transaction identifier with a transaction yet to be billed,” and merely shows the various account numbers and

corresponding transaction identifiers to form a billing statement. (Col. 12: 16-18; col. 12: 30-32) Because the account manager can view the billing statement, the Examiner presupposes that the billing statement contains the claimed account information for “associating each of the plurality of customers with a particular agent among a plurality of agents.” This conclusion is simply without support in *Watson*. In fact, at col. 12: 21-28, apparently in distinguishing the billing statement of FIG. 5 over “traditional billing statements,” *Watson* further states:

Traditional billing statements presented to an account manager contain generic information such as an account number, a transaction amount and information identifying a merchant. Historically, an account manager was then left to search back through claims, work orders or purchase orders to align a transaction amount and merchant identifier contained within the billing statement to an earlier authorization.

There is no mention of any account information for “associating each of the plurality of customers with a particular agent among a plurality of agents” as recited by claim 1 for either the billing statement of FIG. 5 or the “traditional billing statements” of *Watson*, and the apparent distinction of the *Watson* billing statement over the “traditional” statement is the transaction identifier, which is used to uniquely identify a **transaction**, and for which there is no mention whatsoever in *Watson* of its use to associate any customer with any agent.

In addition, the Examiner states, “displaying the list via a web browser to the agent [inherent in personal computer and INTERNET, col 4, lines 61-66, Fig 5, 502].” (Office Action of March 4, 2004, Page 2, lines 22-23) However, col. 4: 61-66 of *Watson* states:

In the present invention, once an account is established with a card issuer, an account manager may perform pre-authorization of transactions with the card issuer directly. In the preferred embodiment, an account manager using a personal computer may routinely generate pre-authorization requests by transferring pre-authorization parameters to the card issuer via the INERNET [sic].

This portion of *Watson* thus discusses an account manager that transfers pre-authorization parameters to a card issuer via the Internet. The general mention of the “Internet” is different from the specific feature of “displaying the list via a web browser to the agent” of claim 1. The Examiner additionally states “Furthermore, *Watson* discloses in Figure 5, 502 a display of multiple customer accounts.” (Office Action March 4, 2004, Page 9, line 1) As discussed previously, FIG. 5 is “a **depiction** of an account report associating a transaction identifier with a transaction yet to be billed” and there is no mention anywhere in *Watson* of any use of a **web browser**, much less of “displaying the list via a web browser to the agent” as recited by claim 1.

A single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Inherent anticipation requires that the missing descriptive material is “necessarily present,” not merely probably or possibly present, in the prior art. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citing *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). There is no display of any list (e.g., the list of Fig. 5) “via a web browser to the agent” that is “necessarily present” in any of the cited portions of *Watson*, and thus claim 1 is not anticipated by *Watson*.

Further, the lack of disclosure of the claim features is consistent with the acknowledgement by the Examiner that “*Watson* ‘750 fails to disclose generating a list of customer accounts corresponding to the particular agent from the account information, and to instruct display of the list via a web browser to the agent,” with respect to the rejection of claims 6, 11, 16, 21, 26, and 32. (Office Action of March 4, 2004, Page 3, lines 17-19)

Therefore, the rejection of claim 1 as anticipated by *Watson* is improper and should be reversed by the Honorable Board.

B. CLAIMS 6, 11, 16, 21, 26, AND 32 ARE NOT RENDERED OBVIOUS BY WATSON AND WALKER ET AL. BECAUSE THEY FAIL TO DISCLOSE “INFORMATION FOR ASSOCIATING EACH OF THE PLURALITY OF CUSTOMERS WITH A PARTICULAR AGENT AMONG A PLURALITY OF AGENTS.”

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne*, 41 USPQ2d 1451 (Fed. Cir. 1997); *In re Deuel*, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Bell*, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner*, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 148 USPQ 721 (CCPA 1966); *In re Freed*, 165 USPQ 570 (CCPA 1970). The Examiner is required to show that all the claim limitations are taught or suggested by the references. *In re Royka*, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 165 USPQ 494 (CCPA 1970).

Obviousness rejections require some evidence in the prior art of a teaching, motivation, or suggestion to combine and modify the prior art references. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The Patent Office must give specific reasons why one of ordinary skill in the art would have been motivated to combine the references. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55

USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Appellant agrees with the acknowledgement by the Examiner that “Watson ‘750 fails to disclose generating a list of customer accounts corresponding to the particular agent from the account information, and to instruct display of the list via a web browser to the agent,” with respect to the rejection of claims 6, 11, 16, 21, 26, and 32. (Office Action of March 4, 2004, Page 3, lines 17-19)

As discussed above, *Watson* does not disclose “account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents,” and *Walker et al.* does not cure the deficiencies of *Watson* in this regard (i.e., “a **controller** such as an online service provider or an ISP **computer**” does not satisfy the recited “particular agent among a plurality of agents” as recited by claim 6).

Walker et al. discloses a method and apparatus for administering a survey, whereby a **controller** such as an online service provider **computer** or an ISP **computer** receives a survey including survey questions from a client desiring to have a survey conducted. (Abstract) The controller creates respondent questions based on the survey questions. The **controller** also selects one or more respondents from a list of possible respondents, such as a list of customer accounts. The respondent questions are transmitted to the selected respondents. Responses corresponding to the respondent questions are received. The controller applies an inconsistency test to the responses to generate an inconsistency test result. The inconsistency test determines if the responses originate from computers or humans not paying attention to the questions. Based on the inconsistency test result, a fraud signal may be generated. The fraud signal may result in several actions, such as the controller ignoring the responses received from the corresponding

respondent, reducing or eliminating payment to the respondent, transmitting a message of reprimand to the respondent, and/or barring the respondent from future participation in surveys.

(Per Abstract, emphasis added)

The Examiner contends, “both Watson and Walker disclose the Internet and a web browser,” (Office Action of March 4, 2004, Page 10, line 3) which is simply not true, as neither reference discloses a “web browser.” Moreover, one of ordinary skill in the art of data processing would not be motivated by this disclosure of *Walker et al.* to instruct **display** of the list of customer accounts to the **controller (i.e., a computer) via a web browser**, as the controller of *Walker et al.* is a **computer** which receives a survey and may select respondents from a list of customer accounts for transmittal of respondent questions, and thus, would not need to **display** anything. Accordingly, *Walker et al.* teaches away from combining its disclosure with *Watson* for the feature “a processor coupled to the communication interface and configured to generate a list of customer accounts corresponding to the particular agent from the account information, and to instruct **display of the list via a web browser to the agent**” as required by claim 6.

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983). A prior art reference must be considered in this entirety including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Therefore, the rejection of claim 6 as obvious over *Watson* in view of *Walker et al.* is improper and should be reversed by the Honorable Board.

For reasons similar to those stated previously with regard to claim 6, Appellant additionally submits that the rejection of independent claims 11, 16, 21, 26, and 32 is improper and should be reversed by the Honorable Board.

C. CLAIMS 2, 7, 12, 17, 22, AND 27 ARE NOT RENDERED OBVIOUS BY WATSON AND PETERS ET AL. BECAUSE THEY FAIL TO DISCLOSE “DRILLING DOWN TO VIEW A PARTICULAR CUSTOMER INVOICE ASSOCIATED WITH A PARTICULAR CUSTOMER ACCOUNT SELECTED FROM THE LIST.”

With regard to the obviousness rejections of claims 2, 7, 12, 17, 22, and 27, Appellant respectfully submits that the many gaps of *Watson* are not filled by the secondary reference of *Peters et al.*, particularly with respect to “account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents; generating a list of customer accounts corresponding to the particular agent from the account information; and displaying the list via a web browser to the agent.” Appellant respectfully submits that, in its rejection of independent claims 6, 11, 16, 21, 26, and 32, the Examiner specifically states, “Watson ‘750 fails to disclose generating a list of customer accounts corresponding to the particular agent from the account information, and to instruct display of the list via a web browser to the agent.” (Office Action of March 4, 2004, Page 3, lines 17-19) In its rejection of claims 2, 7, 12, 17, 22, and 27, the Office Action asserts, “Watson ‘750 discloses the elements of claims 1, 6, 11, 16, 21 and 26 as noted above.” There is no mention of how either of *Watson* or *Peters et al.* suggests or discloses the feature which the Examiner previously acknowledged was not disclosed by *Watson* until the “Response to Arguments” section, in which *Watson* col. 4: 19-35 and col. 4: 60-67 are cited. (Office Action of March 4, 2004, Page 8) As discussed previously, these portions of *Watson* do not suggest or disclose the claimed features.

Claim 2 recites “drilling down to view a particular customer invoice associated with a particular customer account selected from the list.” *Peters et al.* is directed to a method for processing discrete billing events related to batch processing of customer account information in order to perform periodic customer billing. (Abstract and col. 1, lines 22-24) The system of *Peters et al.* subdivides each batch process into segments. The segments execute in a multi-tasking environment as separate processes, yet integrate, upon conclusion, as a single batch entry for continuing processing, thus providing significantly improved resource utilization especially when multi-channel access to the memory storing the discrete events is provided. (Col. 6: 31-37) The Examiner contends that *Peters et al.* discloses “drilling down to view a particular customer invoice associated with a particular customer account selected from the list.” (Office Action of March 4, 2004, Page 4) However, the cited portion of *Peters et al.* merely refers to generating an invoice for processed customer accounts, which, in the batch processing environment of *Peters et al.*, is a starkly contrasting operation from the “drilling down to view a particular customer invoice associated with a particular customer account selected from the list” as recited by claim 2. Appellant respectfully submits that claim 2 additionally recites “generating a list of customer accounts corresponding to the particular agent from the account information; and displaying the list via a web browser to the agent,” which is inconsistent with the batch processing environment of *Peters et al.*

There is no motivation to combine *Watson* and *Peters et al.* because the references constitute non-analogous art. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); see also *In re Clay*, 966 F.2d 656

(Fed. Cir. 1992) (“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”).

Peters et al. is not reasonably pertinent to the problem with which the inventor is concerned, namely an “account management tool for e-billing system” (Title of the Appellant’s application). *Peters et al.* is concerned with the problem of “processing a batch which is distributed into a plurality of independent segments” (Abstract), and *Peters et al.* is blissfully unaware of any problems with account management for e-billing systems.

Additionally, Appellant respectfully submits that neither of the applied references individually, nor in any reasonable combination, suggests or discloses the missing features previously discussed with regard to independent claims 1, 6, 11, 16, 21, and 26, from which each of claims 2, 7, 12, 17, 22, and 27, respectively, depend. Thus, the rejection of claims 2, 7, 12, 17, 22, and 27 as obvious over *Watson* in view of *Peters et al.* is improper and should be reversed by the Honorable Board.

D. CLAIMS 3, 4, 8, 9, 13, 14, 18, 19, 23, 24, 28, 29, 30, 33, AND 34 ARE NOT RENDERED OBVIOUS BY WATSON AND COOK BECAUSE THEY FAIL TO DISCLOSE THE CLAIMED “AUTOMATIC RECEIPT OF AN E-MAIL NOTIFICATION MESSAGE TO NOTIFY ONE OF THE PLURALITY OF AGENTS OF AN EVENT ASSOCIATED WITH THE CUSTOMER.”

Claim 3 recites “providing automatic receipt of an e-mail notification message to notify one of the plurality of agents of an event associated with the customer, wherein the event includes at least one of a new enrollment and an account cancellation” and claim 4 recites “selectively disabling the automatic receipt of the e-mail notification.”

With regard to the obviousness rejection of dependent claims 3, 4, 8, 9, 13, 14, 18, 19, 23, 24, 28, 29, 30, 33, and 34, Appellant respectfully submits that the addition of *Cook* does not fill in the gaps of *Watson*, as discussed previously. *Cook* is directed to a system for selling, manufacturing and distributing a custom digital data product from retail stores, over the Internet, over the telephone, or by electronic means (e.g., fax, e-mail, and the like) wherein a **customer** is provided (e.g., by electronic mail verification) order tracking information. Throughout manufacture and distribution, the **customer** may track the process by activating a hyperlink in one or more e-mail confirmation messages provided by the service provider, or by entering order/tracking numbers from retail terminals or by telephone, or the like. (Abstract) There is no mention or suggestion in *Cook* of “generating a list of customer accounts corresponding to the particular agent from the account information; and displaying the list via a web browser to the agent.” As discussed previously, there is no mention or suggestion of this feature in *Watson*. Appellant respectfully submits no reasonable combination of *Watson* and *Cook* suggests or discloses this feature. Further, there is no suggestion or disclosure of “providing automatic receipt of an e-mail notification message to notify **one of the plurality of agents of an event associated with the customer, wherein the event includes at least one of a new enrollment and an account cancellation,**” as *Cook* is directed to e-mail notification to a **customer** verifying that an order has been accepted for processing or that the order has been shipped. (col. 3: 32-48)

With regard to the Office Action’s assertion of a motivation (Office Action, page 5, lines 10-21) to modify *Watson* “for the purpose of improving the invention by providing a customer with order process updates so that the customer can plan to receive the product,” Appellant respectfully submits that, for example, claim 3 recites, “providing automatic receipt of an e-mail notification message to **notify one of the plurality of agents** of an event associated with the

customer, wherein the event includes at least one of a **new enrollment** and an **account cancellation**.” If the Examiner is equating the “account manager” of *Watson* with the recited “agent” of claim 3, then the Examiner fails to explain how *Watson* is to be modified, with this asserted motivation, to meet the features of claim 3. *Cook* is directed to providing a **customer** “(e.g., by electronic mail verification) order tracking information,” and *Watson* is directed to an account issuer permitting an **account manager** to independently specify the parametric conditions under which to approve a transaction within certain categories such that the account manager may also specify a transaction identifier such as a purchase order, work order or insurance claim number to associate with the required transaction parameters. Upon the approval of such a transaction requiring specific authorization, the authorizing agent during the billing process forwards both the transaction-specific information such as transaction amount and merchant information with the transaction identifier as previously assigned by the account manager.

The Examiner contends that a motivation to modify the combination of *Watson* and *Cook* is “to include providing automatic receipt of an e-mail notification message to **notify one of the plurality of agents** of an event associated with the customer, wherein the event includes at least one of a new enrollment and an account cancellation for the purpose of providing a **means for notifying the customer** of the status of his/her account.” (Office Action of March 4, 2004, Page 5, lines 16-21) However, the Examiner makes no attempt to reconcile this contention with his additional contention of “improving the invention by providing a **customer** with order process updates so the **customer** can plan to receive the product.” (Office Action of March 4, 2004, Page 5, lines 13-15) Appellant respectfully submits that neither of these contentions provides any motivation for any combination of the references for “providing automatic receipt of an e-mail

notification message to notify one of the plurality of agents of an event associated with the customer, wherein the event includes at least one of a new enrollment and an account cancellation” as recited by claim 3.

Obviousness rejections require some evidence in the prior art of a teaching, motivation, or suggestion to combine and modify the prior art references. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The Examiner has shown no such evidence.

Apparently with regard to claims 4, 9, 14, 19, 24, and 30, the Examiner contends, “it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Watson ‘750 and Cook ‘744 to include disabling e-mail notification for the purpose of removing e-mail notification to a person who is no longer a customer.” (Office Action of March 4, 2004, Page 6, lines 13-16) Appellant asserts that the reasoning that the Examiner puts forth for the rejection with respect to “disabling” e-mail notification contravenes 35 U.S.C. § 132, which requires the Director to “notify the applicant thereof, stating the reasons for such rejection.” This section is violated if the rejection “is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 15 USPQ2d 1333 (Fed. Cir. 1990). This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity.” Furthermore, MPEP § 706.02(j) indicates that: “[i]t is important for an

examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to respond.”

Furthermore, the Administrative Procedures Act (APA) mandates the Patent Office to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the reasoning in reaching its conclusions. See *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Gartside*, 203 F.3d 1305, 1314, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000). In particular, the Patent Office must articulate and place on the record the “common knowledge” used to negate patentability. *In re Zurko*, *id.*; *In re Sang Su Lee*, No. 00-1158 (Fed. Cir., Jan. 18, 2002). Here, the Examiner has failed to meet his burden.

Additionally, Appellant respectfully submits that both *Cook* and *Watson* are directed to non-analogous art. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, *supra*; see also *In re Clay*, *supra*. *Cook* is not reasonably pertinent to the problem with which the inventor is concerned, namely an “account management tool for e-billing system” (Title of the Appellant’s application). *Cook* is concerned with the problem of providing a **customer** “(e.g., by electronic mail verification) order tracking information” (Abstract), and *Cook* is nowhere concerned with any problems with account management for e-billing systems.

Additionally, Appellant respectfully submits that neither of the applied references individually, nor in any reasonable combination, suggests or discloses the missing features previously discussed with regard to independent claims 1, 6, 11, 16, 21, and 26, from which each of claims 3, 4, 8, 9, 13, 14, 18, 19, 23, 24, 28, 29, 30, 33, and 34, respectively, depend. Thus, the

rejection of claims 3, 4, 8, 9, 13, 14, 18, 19, 23, 24, 28, 29, 30, 33, and 34 as obvious over *Watson* in view of *Cook* is improper and should be reversed by the Honorable Board.

E. CLAIMS 5, 10, 15, 20, 25, AND 31 ARE NOT RENDERED OBVIOUS BY WATSON AND GOLDBAND ET AL. BECAUSE THEY FAIL TO DISCLOSE “THE CUSTOMER ACCOUNT IN THE STORING STEP IS ASSOCIATED WITH A USER IDENTIFICATION OF THE PARTICULAR AGENT.”

With regard to the obviousness rejections of claims 5, 10, 15, 20, 25, and 31, Appellant respectfully submits that the secondary reference of *Goldband et al.* similarly does not relieve the shortfalls of *Watson*. *Goldband et al.* is directed to broad-based, systematic, individualized, interactive customer software support through a two-way, voluntary automated exchange of information between a software agent installed on a customer's machine and a server machine via a wide area computer network, e.g., the Internet. The agent, with the user's informed consent, gathers activity information about the operations of the software program(s) on a single machine and uploads this information to a particular server machine within a distributed server machine architecture, where it is stored in a database on a per-software-copy basis. A rules engine may cause instructions carrying a message targeted specifically toward the customer (based on the activity information) to be downloaded to the agent. Based on these instructions, the agent may take any of various actions, such as present a survey, present an advertisement, send an upgrade notice, present a limited-time offer, deliver individualized marketing messages, offer goods for sale and fulfill the commercial transaction, install an upgrade or bug fix for either an application or the agent itself, etc. Message presentation to the customer may be timed (e.g., delayed from the time of download) to achieve maximum impact. For example, a message relating to a particular product feature may be presented just after that feature has been used. (Abstract, emphasis added) There is no mention or suggestion in *Goldband et al.* of “generating a list of

customer accounts corresponding to the particular agent from the account information; and displaying the list via a web browser to the agent.” As discussed previously, there is no mention or suggestion of this feature in *Watson*. Appellant respectfully submits no reasonable combination of *Watson* and *Goldband et al.* suggests or discloses this feature.

Claim 5 recites “the customer account in the storing step is associated with a user identification of the particular agent.” The Examiner acknowledges that *Watson* fails to disclose this feature, and thus, relies on *Goldband et al.* (Office Action of March 4, 2004, page 7, lines 3-9) The cited portion of *Goldband* states (paragraph 33):

The Inet plug-in is responsible for handling all Internet traffic. In an exemplary embodiment, it supports various types of Internet transactions, including **registering an agent with the server and obtaining a user ID**, retrieving a command file using the user ID, uploading data to the server, and downloading resources from the server. Data may be exchanged using POST and GET commands, for example, as in the HTTP1.1 protocol. The Inet plug-in is designed to gracefully fail if any transaction is not completed across the Internet.

The Examiner fails to explain how the registration of an agent with a server in *Goldband* relates to the “account manager” of *Watson*. As best understood, the Examiner equates the recited “customer” with the account user 104 of *Watson*, and the recited “agent” with the account manager 102. Appellant has carefully studied *Watson*, and can find no explanation whatsoever for how “wherein the customer account in the storing step is associated with a user identification of the particular agent as taught by Goldbrand [sic] ‘673” achieves any purpose of “uniquely identifying the user.” In fact, observing Fig. 5, which was cited by the Examiner in his rejection of previously discussed claims, the “Account Number” field appears to have already achieved at least this purpose, and thus there would be no motivation for modification. Obviousness rejections require some evidence in the prior art of a teaching, motivation, or suggestion to combine and modify the prior art references. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262

F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Therefore, the rejection of claims 5, 10, 15, 20, 25, and 31 as obvious over *Watson* in view of *Goldband et al.* is improper and should be reversed by the Honorable Board.

IX. CONCLUSION AND PRAYER FOR RELIEF

In view of the arguments proffered, Appellant contends that the rejections under 35 U.S.C. §§ 102 and 103 cannot be sustained. Each of these statutes requires each limitation to be found in the references and a teaching for a combination or modification of the references to flow from the references themselves and not from the application disclosure or generalities. Appellant, therefore, requests the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

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July 27, 2004
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APPENDIX

1. (Original) A method for providing an on-line billing system, the method comprising:
storing account information of a plurality of customers in a database, the account information
including information for associating each of the plurality of customers with a particular
agent among a plurality of agents;
generating a list of customer accounts corresponding to the particular agent from the account
information; and
displaying the list via a web browser to the agent.
2. (Original) The method according to claim 1, further comprising:
drilling down to view a particular customer invoice associated with a particular customer
account selected from the list.
3. (Original) The method according to claim 1, further comprising:
providing automatic receipt of an e-mail notification message to notify one of the plurality of
agents of an event associated with the customer, wherein the event includes at least one of
a new enrollment and an account cancellation.
4. (Original) The method according to claim 3, further comprising:
selectively disabling the automatic receipt of the e-mail notification.
5. (Original) The method according to claim 1, wherein the customer account in the storing
step is associated with a user identification of the particular agent.
6. (Original) A server apparatus for providing an on-line billing system, the server apparatus
comprising:

a communication interface configured to retrieve account information of a plurality of customers in a database, the account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents; and a processor coupled to the communication interface and configured to generate a list of customer accounts corresponding to the particular agent from the account information, and to instruct display of the list via a web browser to the agent.

7. (Original) The server apparatus according to claim 6, wherein the processor is configured to drill down to view a particular customer invoice associated with a particular customer account selected from the list.

8. (Original) The server apparatus according to claim 6, wherein the processor is configured to provide automatic receipt of an e-mail notification message to notify one of the plurality of agents of an event associated with the customer, wherein the event includes at least one of a new enrollment and an account cancellation.

9. (Original) The server apparatus according to claim 8, wherein the processor is configured to selectively disable the automatic receipt of the e-mail notification.

10. (Original) The server apparatus according to claim 6, wherein the customer account is associated with a user identification of the particular agent.

11. (Original) An e-billing system comprising:

a database configured to store account information of a plurality of customers in a database, the account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents;

a server communicating with the database, the server being configured to generate a list of customer accounts corresponding to the particular agent from the account information, and to instruct display of the list via a web browser to the agent; and

a client communicating with the server, the client being configured to run the web browser to display the list.

12. (Original) The system according to claim 11, wherein the server is configured to drill down to view a particular customer invoice associated with a particular customer account selected from the list.

13. (Original) The system according to claim 11, wherein the server is configured to provide automatic receipt of an e-mail notification message to notify one of the plurality of agents of an event associated with the customer, wherein the event includes at least one of a new enrollment and an account cancellation.

14. (Original) The system according to claim 13, wherein the server is configured to selectively disable the automatic receipt of the e-mail notification.

15. (Original) The system according to claim 11, wherein the customer account is associated with a user identification of the particular agent.

16. (Original) A server apparatus for providing an on-line billing system, the server apparatus comprising:

means for storing account information of a plurality of customers in a database, the account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents;

means for generating a list of customer accounts corresponding to the particular agent from the account information; and

means for displaying the list via a web browser to the agent.

17. (Original) The server apparatus according to claim 16, further comprising:

means for drilling down to view a particular customer invoice associated with a particular customer account selected from the list.

18. (Original) The server apparatus according to claim 16, further comprising:

means for providing automatic receipt of an e-mail notification message to notify one of the plurality of agents of an event associated with the customer, wherein the event includes at least one of a new enrollment and an account cancellation.

19. (Original) The server apparatus according to claim 18, further comprising:

means for selectively disabling the automatic receipt of the e-mail notification.

20. (Original) The server apparatus according to claim 16, wherein the customer account is associated with a user identification of the particular agent.

21. (Original) A computer-readable medium carrying one or more sequences of one or more instructions for providing an on-line billing system, the one or more sequences of one or more instructions including instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of:

storing account information of a plurality of customers in a database, the account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents;

generating a list of customer accounts corresponding to the particular agent from the account information; and

displaying the list via a web browser to the agent.

22. (Original) The computer-readable medium according to claim 21, wherein the one or more processors further perform the step of:

drilling down to view a particular customer invoice associated with a particular customer account selected from the list.

23. (Original) The computer-readable medium according to claim 21, wherein the one or more processors further perform the step of:

providing automatic receipt of an e-mail notification message to notify one of the plurality of agents of an event associated with the customer, wherein the event includes at least one of a new enrollment and an account cancellation.

24. (Original) The computer-readable medium according to claim 23, wherein the one or more processors further perform the step of:

selectively disabling the automatic receipt of the e-mail notification.

25. (Original) The computer-readable medium according to claim 21, wherein the customer account in the storing step is associated with a user identification of the particular agent.

26. (Original) An account management tool for sales representatives of an enterprise employing an e-billing system including a computer system accessible for on-line interactive communication of product and service invoices to users, the account management tool comprising:

a database for storing customer account information including customer invoices, the customer information including information for associating a customer account with a particular sales representative;

a mechanism for retrieving from the database a list of all customer accounts associated with the sales representative; and

device for transmitting a list of the customer accounts associated with the sales representative to a sales representative browser device for display thereof, whereby customer account information associated with the sales representative is available for review.

27. (Original) The account management tool according to Claim 26, further including a drill-down mechanism for enabling viewing of a particular customer invoice associated with a particular customer account selected from the customer account list.

28. (Original) The account management tool according to Claim 26, further including e-mail notification mechanism enabling a sales representative to specify automatic receipt of e-mail notification message when a new customer is enrolled for e-billing.

29. (Original) The account management tool according to Claim 28, further including e-mail notification mechanism enabling a sales representative to specify automatic receipt of e-mail notification message when a customer cancels an e-billing customer account.

30. (Original) The account management tool according to Claim 29, further including mechanism for enabling a sales representative to disable the e-mail notification mechanism.

31. (Original) The account management tool according to Claim 26, wherein the customer account is associated with a user ID of the sales representative and recognized by the e-billing system.

32. (Original) A method for tracking customers enrolled in an e-billing system employed by an enterprise, the e-billing system including a computer system accessible for on-line interactive communication of product and service invoices to customers, the method comprising:

tracking enrolled customers and associated customer account information, and storing customer account information including customer invoices of the enrolled customers in a database, associating enrolled customers with a particular sales representative of the enterprise;

retrieving from the database a list of all customer accounts associated with the sales representative; and

transmitting a list of the customer accounts associated with the sales representative to a sales representative browser device for display thereof, whereby customer account information associated with the sales representative is available for sales representative review.

33. (Original) The method according to Claim 32, wherein upon determination of a new customer enrolled in the e-billing system, the step of automatically notifying the sales representative of the new enrolled customer.

34. (Original) The method according to Claim 33, wherein upon determination of a customer being deleted from the e-billing system, the step of automatically notifying the sales representative of the deleted customer.